

Remarks:

Claims 16-35, are pending—claim 35 being newly added.

Claims 1-15 are cancelled, without prejudice or disclaimer.

Claim 30 is amended to correct a readily apparent clerical error.

Claims 24-26 are amended to specify the recited molecular weights are based on "(Mw)," such as found in the instant specification (e.g., page 9, 3rd complete paragraph).

Claims 28 and 29 are amended by changing "swell able" (each occurrence) to "swellable."

Accordingly, the objection to the claims at issue is overcome, and withdrawal of the objection is in order.

Present (new) claim 35 further limits the "adhesive composition" (of claim 16) to "the block-copolymer...polyisobutylene (SIBS) and...the homopolymer...polyisobutylene (PIB)," as described in the instant specification (e.g., page 6, 3rd complete paragraph).

Claims 24-26 were rejected under 35 USC 112, second paragraph, as allegedly being indefinite. Reconsideration is requested in view of the changes to the rejected claim, effected hereby.

As explained above, and in compliance with the rejection, claims 24-26 are amended to specify the molecular weight "Mw."

In view of the foregoing amendment to the rejected claims, the rejection of claims 24-26 under §112, ¶ 2, is overcome. Withdrawal of the rejection is in order.

Claims 16-20, 22, 23, 27, and 30 were rejected under 35 USC 102(b) for allegedly being anticipated by US2002/0077420 (Chiba). Reconsideration is requested.

For anticipation under § 102 to exist, each and every claim limitation, as arranged in the claim, must be found in a single prior art reference. *Jamesbury Corp. v. Litton Industrial Products, Inc.*, 225 USPQ 253, 256 (Fed. Cir. 1985) ("Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim"). The "absence" from a prior art reference of a single claim limitation "negates anticipation." *Kolster Speedsteel A B v. Crucible Inc.*, 230 USPQ 81, 84 (Fed. Cir. 1986). A reference that discloses "substantially the same...invention" is not an anticipation. *Jamesbury Corp.*, 225 USPQ at 256 ("anticipation is not shown by a prior art disclosure which is only 'substantially the same' as the claimed invention"). To anticipate the claim, each claim limitation must "identically appear" in the reference disclosure. *Gechter v. Davidson*, 43 USPQ2d 1030, 1032 (Fed. Cir. 1997). To be novelty defeating, a reference must put the public in possession of the identical invention claimed. *In re Donahue*, 226 USPQ 619 (Fed. Cir. 1985).

The rejected claims define an "adhesive composition" comprising components (i.e., limitations) (a) a "block-copolymer" and (b) a "homopolymer...wherein the homopolymer is a linear or branched, saturated hydrocarbon chain" (emphasis added). According to the rejection (Office Action, page 3), the component (b) "homopolymer" is met because, allegedly, "Chiba...teaches an adhesive composition comprising...a homopolymer...wherein the homopolymer is a linear or branched, hydrocarbon chain" (emphasis added). With all due respect, the allegation is incorrect.

Chiba (paragraphs [0006]-[0008]) describes an "invention...directed to a curable composition which comprises (A) a block copolymer...and (B) an isobutylene polymer having a silicon group" (emphasis added). Since the "isobutylene polymer" [component (B) in Chiba] must include a "silicon group," Chiba's component (B) does not teach (or even suggest) the "homopolymer" [component (b)] of the rejected claims, which "homopolymer" is limited to a "hydrocarbon" (emphasis added).

That is, *hydrocarbon* is a well known term in the art, having a well defined meaning. As readily apparent to one skilled in the art, a *hydrocarbon* is a "compound consisting of only C [carbon] and H [hydrogen]." *Hackh's Chemical Dictionary*, 4th Ed., New York, McGraw-Hill Inc., 1969, page 331 (emphasis added) (copy provided herewith). As such, the examiner incorrectly alleges (Office Action, page 3) (emphasis added) "Chiba...teaches an adhesive composition comprising...a homopolymer...wherein the homopolymer is a linear or branched, hydrocarbon chain."

Accordingly, the "absence" from Chiba of the hydrocarbon-homopolymer limitation of the rejected claims "negates anticipation" of any of the present claims by the cited reference. *Kolster Speedsteel AB*, 230 USPQ at 84. Since each limitation of the present claims does not "identically appear" in the Chiba disclosure, the reference cannot anticipate any of the present claims. *Gechter*, 43 USPQ2d at 1032.

In view of the foregoing remarks, the rejection of claims 16-20, 22, 23, 27, and 30 under §102(b), as allegedly anticipated by Chiba, is overcome. Withdrawal of the rejection is in order.

Claims 24-26 were rejected under 35 USC 103(a) for alleged obviousness over Chiba. Reconsideration is requested.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art," *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970), "and it is error to ignore specific limitations distinguishing over the [prior art] reference." *Ex parte Murphy*, 217 USPQ 479, 481 (PO Bd. App. 1982). A "ground of rejection is simply inadequate on its face...[when] the cited references do not support each limitation of [the] claim." *In re Thrift*, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002).

Chiba is relied upon to meet the hydrocarbon "homopolymer" component (b) of the rejected claims, in the same way the reference was relied upon, mistakenly, in the §102 rejection (explained above). Accordingly, since "the cited reference...[does] not support each limitation of [each] claim," the obviousness rejection of claims 24-26 over Chiba is "inadequate on its face." *Thrift*, 63 USPQ2d at 2008.

In view of the foregoing remarks, the rejection of claims 24-26 under §103(a) for alleged obviousness over Chiba is overcome. Withdrawal of the rejection is in order.

Claims 16-32 were rejected under 35 USC 103(a) for allegedly being obvious over US 6558792 (Vaabengaard) in view of Chiba. Claims 33 and 34 were rejected under 35 USC 103(a) for allegedly being obvious over Vaabengaard in view of Chiba—relied upon in the same manner

Secondly, and with all due respect, the §103 rejections at issue—relying upon combinations of cited references—impermissibly "use hindsight reconstruction to pick and choose among isolated disclosures in the [Chiba and Vaabengaard] prior art to deprecate the claimed invention." *Fine*, 5 USPQ2d at 1600. More precisely, the rejection impermissibly attempts "to pick and choose from [Chiba] . . . only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what [Chiba] . . . fairly suggests to one of ordinary skill in the art." *Hedges*, 228 USPQ at 687. The rejections allege (Office Action, page 11)

it would have been obvious to one of ordinary skill in the art . . . to use SIBS [block copolymer] of Chiba et al. as the elastomer of Vaabengaard et al. for the benefit of obtaining an adhesive having low moisture permeability.

The allegation is poorly taken, since it excludes "other parts necessary to the full appreciation of what [Chiba] . . . fairly suggests to one of ordinary skill in the art." *Hedges*, 228 USPQ at 687.

That is, Chiba (abstract, paragraph [0005], claim 1) teaches as invention a "curable composition" indispensably containing "an isobutylene polymer having a silicon group bound to a hydrolyzable group or a hydroxyl group" (emphasis added). Although indispensable to Chiba, the rejection excludes this silicon-group containing isobutylene polymer that is "necessary to the full appreciation of what such reference fairly suggests to one ordinary skill in the art," and does so in order to "pick and choose . . . only so much of [Chiba] as will support [the rejection] . . . position" (i.e., Chiba's SIBS block copolymer), which "[exclusion] is impermissible within the framework of §103." *Hedges*, 228 USPQ at 687.

as in the rejection of claims 16-32 (above)—and further in view of US5109874 (Bellingham). Reconsideration of the rejections is requested.

"One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

It is impermissible within the framework of §103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

In re Hedges, 228 USPQ 685, 687 (Fed. Cir. 1986). *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988) ("it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention"). Teachings of the prior art must be taken as a whole in an obviousness analysis. *Ryko Manufacturing Co. v. Nu-Star, Inc.*, 21 USPQ2d 1053 (Fed. Cir. 1991).

First of all, to the extent one or both of the §103 rejections may rely on Vaabengaard, alone, the reliance is misplaced. The "homopolymer" component of the presently claimed adhesive composition is "made from the same monomer" contained in "at least one block" of the "block-copolymer" component. On the other hand, as implicitly admitted in the §103 rejections, Vaabengaard neither teaches nor suggests a block-copolymer/homopolymer containing composition in which the homopolymer, and at least one block of the block copolymer, are "made from the same monomer," as in the rejected claims. Accordingly, since "the cited [Vaabengaard] reference . . . [does] not support each limitation of [each] claim," each of the obviousness rejections at issue, if relying upon Vaabengaard alone, is "inadequate on its face." *Thrift*, 63 USPQ2d at 2008.

Moreover, the §103 rejections at issue—relying upon combinations of cited references—cannot be maintained because the cited references teach away from both the combinations relied upon and from the presently claimed invention.

"A reference may be said to teach away [from an applicant's invention] when a person of ordinary skill, upon reading the reference, would be...led in a direction divergent from the path that was taken by the applicant," *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994), and "an applicant may rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect." *In re Peterson*, 65 USPQ2d 1379, 1384 (Fed. Cir. 2003).

References teach away from being combined when the combination eliminates the invention on which one of the references is founded. *In re Sponnoble*, 160 USPQ 237, 244 (CCPA 1969). *Ex parte Hartmann*, 186 USPQ 366, 367 (POBdApp 1974) (references "cannot properly be combined... [if] to do so would destroy that on which the invention of...[one] is based"). *Tec Air, Inc., v. Denso Manufacturing Michigan Inc.*, 52 USPQ2d 1294, 1298 (Fed. Cir. 1999) ("There is no suggestion to combine...if a reference teaches away from its combination with another source"). When one of two cited references is found to "teach away from [the other], then that finding alone can defeat the obviousness claim." *Winner Int'l. Royalty Corp. v. Wang*, 53 USPQ2d 1580, 1587 (Fed. Cir. 2000), *cert. denied*, 530 U.S. 1238 (2000).

As explained above, Chiba indispensably requires a silicon-group containing isobutylene homopolymer; whereas, the rejected claims are limited to a "hydrocarbon" homopolymer.

Accordingly, the "reference [Chiba] may be said to teach away . . . [since] a person of ordinary skill, upon reading the reference, would be...led in a direction divergent from the [hydrocarbon homopolymer] path that was taken by the applicant." *Gurley*, 31 USPQ2d at 1131. In other words, applicants effectively "rebut...[any] prima facie case of obviousness by showing that the prior art teaches away from the claimed invention in...[a] material respect." *Peterson*, 65 USPQ2d at 1384.

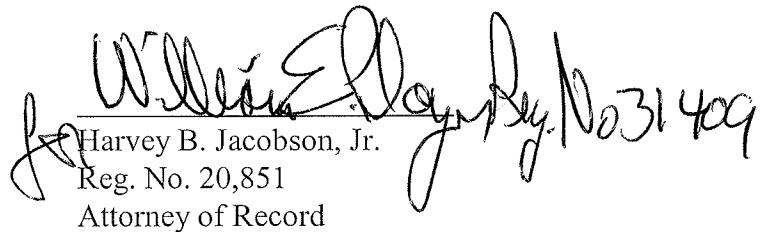
Still further, since Chiba indispensably requires the presence of a silicon-containing homopolymer Chiba "cannot properly be combined" with Vaabengaard, as alleged in the rejections, since "to do so would destroy that on which the invention of . . . [Chiba] is based." *Hartmann*, 186 USPQ at 367. And, since Chiba and Vaabengaard "teach away [from being combined], then that finding alone can defeat the obviousness claim." *Winner Int'l. Royalty Corp.*, 53 USPQ2d at 1587.

In view of the foregoing remarks, the rejection of claims 16-32 under §103(a) for alleged obviousness over Vaabengaard in view of Chiba, and the rejection of claims 33 and 34 under §103(a) for alleged obviousness over Vaabengaard in view of Chiba and further in view of Bellingham, are overcome. Withdrawal of the rejections is in order.

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Favorable action is requested.

Respectfully submitted,


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